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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/748,745
Filing Date: December 30, 2003
Appellant(s): LEBLANG, JONATHAN

David N. Weiss
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/14/2009 appealing from the Office action mailed 03/23/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0077929	Knorr et al.	6-2002
2004/0260710 A1	Marston et al.	12-2004
2003/0097311 A1	Shinohara et al.	5-2003

Art Unit: 3628

2005/0010857 A1

Shmukler et al.

1-2005

2003/0130903

Silverbrook

7-2003

Official Notice as supported by Shmukler

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

Claim 50 is objected to because of the following informalities:

Applicant's preamble recites, "an apparatus stored on a computer readable medium". **Appropriate correction is required.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1.

As per Claims 1 and 50, Knorr teaches a database that stores article identification information and article location information for a plurality of articles (see para. 17 and 22); a first module that determines at least a shipment date when a pending user order is to be shipped, wherein the pending order was placed via a computer network during a first network session (see para. 50); a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order (see para. 65); and a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment (see para. 65, Examiner is interpreting interacting with the customer as notifications).

As per Claims 3 and 52, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the third module causes the notification to be presented to the user at least partly in response to determining that the user is accessing the computer network (see para. 42).

As per Claims 6 and 55 Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the notification includes an order incentive offer (see para. 42).

As per Claims 9 and 58, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on at

least one article type in the pending order (see para. 65, Examiner is interpreting cross-selling as being based on an article type of a pending order).

As per Claims 10 and 59, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on user history order information retrieved from the database (see para. 65).

As per Claim 12 and 61, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on user preference information retrieved from the database (see para. 42 and 65).

As per Claim 13 and 62, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the notification is provided to the user at least-one after the pending order was placed (see para. 42 and 65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 51 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Marston et al. U.S. Pre-Grant Publication No. 2004/0260710 A1.

As per Claims 2 and 51, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Martson wherein the notification is an icon displayed via a toolbar on a user terminal (see para. 32). It would

have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Marston to alert a user of a change in a system.

Claims 4 and 53 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Shinohara et al. U.S. Pre-Grant Publication No. 2003/0097311 A1.

As per Claim 4 and 53, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Shinohara wherein the notification is provided via an email transmitted to a user email address (see para. 187). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Shinohara to receive the status of an ordered item.

Claims 5 and 54, are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Official Notice as supported by Shmukler et al 2005/0021664 A1.

As per Claims 5 and 54, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by in view of Official Notice as supported by Shmukler wherein the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired (see para. 82 and 84-86). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of

in view of Official Notice as supported by Shmukler to provide adequate order and offer information to a user.

Claims 8, 11, 57 and 60 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Official Notice.

As per Claims 8 and 57, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach wherein the location information is used by the second module to determine how long it would take to transport the first article from a storage area to a packing area. Official Notice is taken that using location information to determine transport time to an area is old and well known. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Official Notice to calculate an estimated shipment date.

As per Claims 11 and 60, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach, wherein the first article is identified based in part on the quantity of the first article in inventory in an order fulfillment center from which at least one article in the pending order is to be shipped. Official Notice is taken that identifying and article based on a quantity available in a shipping center is old and well known. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Official Notice to up-sell overstocked items.

Claims 7 and 56 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Silverbrook et al. U.S. Pre-Grant Publication No. 2003/0130903.

As per Claims 7 and 56, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Silverbrook a fourth module, that, during a second network session, provides that user with an interface via which the user can add the at least first article to the pending order (see para. 558). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Silverbrook to allow a user the flexibility to alter an order.

(10) Response to Argument

A. Introduction

The primary prior art reference, Knorr et al; is directed to a system for processing electronically pending order items purchased from on-line catalogs. A purchaser in the system of Knorr is able to purchase items in advance of a specifically requested delivery date (see Fig. 3). The order is then pended in a database until the final order execution corresponding to a specific delivery date as indicated by the purchaser (see para. 8).

B. Knorr teaches a second and third identification and notification module as claimed

Appellant argues that Knorr does not teach "*a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the*

shipment date of the pending order and a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment." The Examiner disagrees. Knorr teaches that while an order is pending, the system can notify a purchaser about adding or upgrading an item to the pending order. Specifically Knorr teaches,

For example, the order pending database owner may implement a system by which, in conjunction with product availability confirmation messages as described herein, the order pending database owner can provide for notification of product upgrades or new models or versions, to a purchaser during the period in which a transaction is pending. The purchaser may be presented with a message informing them of a possible product upgrade they may wish to take advantage of, with an option to effect the upgrade (see para. 50).

As plainly described above, a purchaser in the system of Knorr can add additional items or upgrade an item to a pending order. A purchaser of the system of Knorr can also add/upgrade items without delaying the shipment date of the pending order. Specifically Knorr teaches,

For example, the order pending database owner may implement a system by which, in conjunction with product availability confirmation messages as described herein, the order pending database owner can provide for notification of product upgrades or new models or versions, to a purchaser during the period in which a transaction is pending. (see para. 50). At the parent vendor's fulfillment date, which can be defined by the parent vendor as a specific number

of days prior to the event date, the order pending system executes an order with the e-vendor at step 162. The order having been transmitted to the parent e-vendor, it is fulfilled and shipped at step 164. The parent vendor can bill the order pending system at step 166. In some methods, the customer is billed directly by the parent vendor. In the embodiment illustrated, at step 168, the order pending system bills the purchaser. At step 170, the recipient receives the items no later than the requested delivery date, which in this case is the occasion date, e.g. Mother's Day. (see para. 51)

As described, the purchaser is given suggestions of items to add to a pending order which is already set to arrive on a specific day as previously requested by the purchaser (ie. Mother's Day). One can clearly add to the order without effecting the previously set delivery date. If an item is unable to be fulfilled in time for a scheduled delivery date, the system of Knorr provides a notification and suggests alternatives.

Similarly, the purchaser may be notified of situations in which the pended order item may not be available. The purchaser may be presented with options for alternate products they may wish to substitute. A vendor may wish to offer a discount in connection with this alternate or "second choice" suggestion. Alternately, a vendor may, in the case of product unavailability, have the order filled by a third party or alternate supplier, in a manner that is transparent to the purchaser and recipient, in order to maintain customer loyalty. The vendor may, for example, notify the order pending database administrator of the product unavailability, and either present an alternate or substitute product, or request help in having the order filled through another fulfillment entity, preferably transparently (see para. 50).

In the system of Knorr not only can a person add to a pending order without delaying the shipment date by purchasing an item, they can also add to a pending order by consolidating the shipment of items. Specifically Knorr teaches:

In the purchaser path at 540, the purchaser may optionally input instructions about shipping, consolidating item requests, special handling, or other changes at any time during the monitoring mode. The order pending shopping cart may also be cancelled or modified anytime during the monitoring mode (see para. 65).

Further, Knorr provides a purchaser with a notification of the last chance to add/change an order during the monitoring mode, which is described as a period of time between the initial order and the order execution (see para. 45 and 61-

62). Specifically Knorr teaches,

In one embodiment of the present invention, when an order is received, the scheduler will read the scheduled delivery date, and after calculating based on vendor lead time and shipping data, will determine one or more interim reminder or notification periods or dates ("period" herein referring to a length of time or a particular date), a verification period, item confirmation period, event billing period, order execution period, and order confirmation period as a part of the method which manages the vendor stream of routines. The scheduler may also assign required daily monitoring, system management functions, and exception management routines. On the part of the purchaser stream of routines for that transaction, the scheduler may similarly calculate an order confirmation period, interim or mid-point reminder period(s) or date(s), last chance to change or cancel reminder period, event billing period, occasion reminder period, transaction completed notification period, and recipient follow-up

period (see para. 20).

A purchaser in the system of Knorr has the option to add items to a currently pended order, including consolidating pended shipments, without effecting the previously scheduled delivery date. They also receive notifications of the last chance to change or cancel a pended order during the monitoring period. Accordingly, contrary to Appellant's assertions, Knorr teaches identifying at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order and notifying a user that they can add at least the first article to the pending order without delaying the pending order shipment.

C. Knorr is structurally capable of performing the second and third identification and notification as claimed

The Examiner has asserted that Knorr teaches the system of claims 1 and 50 as claimed. Additionally or in the alternative, the system of Knorr is capable of identifying at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order and notifying a user that they can add at least the first article to the pending order without delaying the pending order shipment. **The Examiner notes:** While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In this case the structural system of Knorr is capable of identifying at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending

order and notifying a user that they can add at least the first article to the pending order without delaying the pending order shipment, therefore it meets the limitations of the claim.

Further, "Apparatus claims cover what a device *is*, not what a device *does*."
Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the order pending database and system of Knorr is structurally identical to the system components recited in Appellant's claims language.

D. Appellant is arguing the claim language more narrowly than recited

Appellant further argues with respect to claims 10 and 59, *While Knorr refers to a pending order database and to suggestive selling, the citation relied upon by the Office Action does not expressly or inherently disclose that the suggestive selling of Knorr involves identifying an article that can be added to the pending order based in part on user history order information retrieved from a database, much less the invention as claimed*. The Examiner disagrees. The pending order in Knorr is stored in the database. The system uses this stored information to suggest items for cross-selling and upgraded suggestions. Specifically, Knorr teaches,

In a preferred embodiment of the subject invention, the administrator of the **order pending database** may implement a system to aid in logistics assurance, for example, in partnership with a third-party e-vendor. For example, the **order pending database** owner may implement a system by which, in conjunction with product availability confirmation messages as described herein, the **order pending database** owner can provide for notification of product

upgrades or new models or versions, to a purchaser during the period in which a transaction is pending. The purchaser may be presented with a message informing them of a possible product upgrade they may wish to take advantage of, with an option to effect the upgrade (see para. 50). As indicated in the electronic vendor path at 546, the vendor can use the time between the electronic hold and the ultimate order execution to plan inventory and interact with the purchaser for suggestive sellings, i.e., up-selling and or cross-selling. Other suggestive selling opportunities may be afforded in conjunction with the logistics assurance modality discussed earlier (see para. 65).

As shown above, the information regarding the item that is currently pending is stored in the database and retrieved for the purposes of up selling or upgrading an order.

Appellant further asserts with respect to claims 12 and 61 that Knorr does not teach identifying an article that can be added to the pending order based in part on preference information of a user placing an order, wherein the preference information is retrieved from a database". The Examiner disagrees. Knorr plainly teaches this limitation. Specifically, Knorr teaches,

In some methods, the event profile data elements are obtained directly from the recipient or the purchaser, for example, by keying into the order pending application. In some situations, a third-party database, such as a PDA database or electronic address book can be the electronic source of the event information...For example, a purchaser or potential purchaser may be presented with an array of events entered in their scheduler for which they may wish to pend an order with the order pending database. Based on this body of events, periodic reminders of events for which no order is pended may be presented to the

purchaser to suggest pending an order, or even suggesting suitable items pertinent to widely-recognized events such as holidays, perhaps with regard to certain individuals from the purchaser's personal individual contacts database. (see para. 42).

As shown above, Knorr plainly teaches identifying an article that can be added to the pending order based in part on preference information of a user placing an order wherein the preference information is retrieved from a database.

In response to Appellant's argument that the notification referred to in claims 4 and 53 is not for providing the status of an ordered item, the fact that Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Appellant further argues with respect to claims 5 and 54 that Shmukler does not disclose a notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount of time to add articles to the pending order has expired. The Examiner disagrees. Specifically, Shmukler teaches,

When a user receives the newsletter-(notification) and has an interest in one or more of the items described therein, the user may obtain additional information by clicking on the particular hyperlink. As an example, if the user were to click on the first hyperlink 802, he or she would be directed to additional information about this item in the form of another screen 900, i.e., an HTML

document, as shown in FIG. 9. (see para. 82)

If a user clicks on the "expired" link, he or she may be directed to an explanatory screen 1200, as shown in FIG. 12. A section 1202 then explains that the selected items is no longer available (see para. 87).

As described above, the system of Shmukler plainly teaches the recited limitation. **The Examiner notes:** Shmukler was incorrectly cited as Pre-Grant Publication No. 2005/0021664 A1 as opposed to 2005/0010857 A1 in the final Office action dated 003/23/2009. The correct citation appears on the PTO-892 mailed on 03/23/2009 and the Appellant had sufficient notice as to the grounds of rejection.

Appellant further argues, with respect to claims 2, 7-8, 11, 51, 56-57 and 60 that the Examiner has failed to articulate a clear rationale for modifying Knorr with the recited references. The Examiner disagrees. As of the most previous Office Action, the Examiner established a *prima facie* case and the burden was shifted to the Appellant. Appellant has failed to provide supporting evidence as to why the combinations are insufficient, and has only relied on mere conclusory statements for support.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tonya Joseph

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